

Group IV: Claim 26 drawn to a fusion protein that specifically binds to an internal structure;

Group V: Claims 27 and 28, drawn to a nucleic acid encoding a fusion protein;

Group VI: Claim 29 drawn to a fusion protein comprising a detectable protein and a translocatable protein;

Group VII: Claims 30 and 31, drawn to a nucleic acid encoding a fusion protein;

Group VIII: Claims 32-35, drawn to a kit for detecting protein-protein interaction within a living cell; and

Group IX: Claims 36-45 drawn to a nucleic acid library.

This requirement is respectfully traversed. Reconsideration and removal thereof are requested.

The Examiner has issued the rejection claiming that the application contains inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rules 13.1 and 13.2. Applicants submit that the Examiner has not properly construed or applied the unity of invention standard applicable under PCT Rules 13.1 and 13.2. The Examiner will note that a unity of invention objection was raised during the international phase of this application. The Examiner in the international phase, interpreting the claims under PCT Rule 13.1 and 13.2, separated the claims into 7 groups of invention. Applicants submit that a similar finding of unity of invention should follow when the rules are applied during the national phase of prosecution.

As a preliminary matter, Applicants note that the Examiner argues that the "special technical feature" (i.e. the fusion protein) common to the claims of group I (claims 1-6) fails to

define a contribution over the prior art (WO 00/17221). Applicant would like to point out that WO 00/17221 corresponds to PCT publication PCT/US99/19118. The present application is, therefore, the national phase application of WO 00/17221, so that, WO 00/17221 does not qualify as prior art to the present application. Thus, Applicant fails to see how the Examiner has used the WO 00/17221 to support her position that the present invention fails to make a contribution over the prior art.

Turning to the substance of the restriction requirement, Applicants maintain that the Examiner has failed to properly apply the unity of invention guidelines. The PCT guidelines clearly state that only the independent claims are to be considered when determining if unity of invention exists in an international application. Yet, the misapplication of PCT Rules is evident when one considers that the Examiner placed claims 8-25 in a separate group despite the fact that these claims ultimately depend from claim 1 of Group I. The Examiner argues that the claims of Group II are directed to a library of proteins. Contrary to the Examiner's position, Applicants submit that claims 8-25 are also directed to a method of detecting protein-protein interactions.

Applicants would again urge the Examiner to rejoin claims 1-6 and 8-25 within Groups I and II as was done in the international phase. These groups of claims are both directed to a method of detecting protein-protein interactions. It would be reasonable to search and examine the substance of these two groups concurrently as the areas to be searched are coextensive and the Examiner would not be placed under an undue burden.

In view of the foregoing remarks, Applicants provisionally elect search and examination for the claims of Groups I and II, namely claims 1-25. If, however, the Examiner maintains the full scope of the restriction requirement, Applicants elect to prosecute the claims of Group I.

Favorable action and early allowance of the claims are requested.

If the Examiner has any questions concerning this application, he is requested to contact Leonard Svensson (Reg. No.: 30,330) the undersigned at (714) 708-8555 in the Southern California area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

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(Date of deposit)

BIRCH, STEWART, KOLASCH & BIRCH, LLP

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May 17, 2002
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Respectfully submitted,

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